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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,111	02/11/1999	ICHIRO NAKANO	1046.1196/JD	8405
21171	7590	05/24/2007	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			AN, SHAWN S	
		ART UNIT	PAPER NUMBER	
		2621		
		MAIL DATE	DELIVERY MODE	
		05/24/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/248,111	NAKANO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shawn S. An	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 23 February 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 5-22 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4 and 24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2621

## **DETAILED ACTION**

### ***Response to Amendment***

1. As per Applicant's instructions as filed on 2/23/07, claims 1-4 and 24 have been amended, and claim 23 has been canceled.

### ***Claim withdrawn due to Applicant's Restriction/Election Response***

2. Applicant has elected without traverse of the Fig. 1 corresponding to claims 1-4 as filed on 1/23/04.

However, Applicant's amended claim 2 with respect to the amended feature now belongs in Species II, corresponding to Fig. 2.

Therefore, since Applicant has elected the species I representing Fig. 1, the amended claim 2 is now treated as being withdrawn claim.

### ***Response to Remarks***

3. Applicant's arguments with respect to amended claims with the exception of claim 2 have been carefully considered but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The claimed invention is directed to non-statutory subject matter.

Claim 4 (in preamble) comprises non-statutory subject matter.

Art Unit: 2621

The following is an example of acceptable language in overcoming non-statutory subject matter:

- A. "A computer readable medium" storing a "computer program . . .,"

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 3, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi et al (6,256,346 B1).

**Regarding claims 1 and 3,** Yamaguchi et al discloses a moving image data controlling apparatus, comprising:

a moving image source input unit (Fig. 5, 700) inputting moving image data;

a moving image data encoding unit (140) compressing the moving image data from the moving image source input unit;

an information input unit (50) inputting control/additional information externally produced and designating a processing for arbitrary designated partial image data (object) of the moving image data inputted through the moving image source input unit, wherein the processing is implemented to the moving image data in entirety (col. 20, lines 25-40)

a control information encoding unit (140) compressing the control/additional information from the information input unit;

Art Unit: 2621

a data integrating unit (150) integrating the compressed image data from the moving image data encoding unit with the compressed control information from the control information encoding unit; and

storing the integrated moving image data and the control information (160).

**Regarding claim 24**, Yamaguchi et al discloses a method of controlling image data, comprising;

compressing the moving image data (Fig. 5, 140);

designating an arbitrary portion (partial image data) among portions (object, background) forming the moving image data, and defining the arbitrary position (bit-map, alpha-map) as control/additional information for the moving image data in entirety, the control information being compressed (140; col. 20, lines 25-40); and

controlling the moving image data by integrating the compressed moving image data and the compressed control information (150).

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al (6,256,346 B1) in view of Hancock et al (6,195,391 B1).

**Regarding claim 4**, Yamaguchi et al discloses all of the claimed subject matter as discussed above with respect to claim 3 with the exception of preamble (a computer readable medium ..., to execute operations).

However, Hancock et al teaches hybrid video compression/decompression system comprising performing/practicing the invention on a digital computer system storing a

program which when executed by a computer causes the computer to execute operations (col. 4, lines 45-53), and also teaches bit-map encoding (col. 3, lines 11-17).

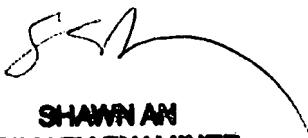
Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing a moving image data controlling apparatus as taught by Yamaguchi et al to incorporate Hancock et al's teachings as above so that a computer readable medium stores a (computer) program which when executed by a computer causes the computer to execute Yamaguchi's claimed method (as in claim 3), thereby saving significant overhead costs associated with manufacturing hardware.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Shawn S An whose telephone number is 571-272-7324.
12. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SHAWN A.  
PRIMARY EXAMINER**